



UNITED STATES
PATENT AND
TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY
AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
PO BOX 1450, ALEXANDRIA, VA 22313-1450
WWW.USPTO.GOV

JUN 30 2003

HUNTON & WILLIAMS
INTELLECTUAL PROPERTY DEPARTMENT
1900 K STREET, N.W.
SUITE 1200
WASHINGTON DC 20006-1109

19

In re Application of :
Thomas Piccariello et al :
Serial No.: 09/933,708 : PETITION DECISION
Filed: August 22, 2001 :
Attorney Docket No.: 54719.000028 :

This is a response to the petition under 37 CFR 1.59(b), filed April 11, 2003, to expunge information from the above identified application.

Petitioner requests that an Information Disclosure Statement (IDS), filed March 25, 2003, be expunged from the record. The petition fee set forth in 37 CFR 1.17(h) has been paid.

A review of the file shows that the IDS is present in the file. The IDS consists of citations of US patents and published applications and non-patent literature publications available to the public as well as a number of items relating to presentations, etc. Applicants request return of the entire IDS. However, it would not be appropriate to return information contained in an IDS which is available to the public and may have a bearing on the patentability determination to be made by the examiner. It is noted that information which is considered confidential may be submitted for examiner consideration in accordance with 37 CFR 1.59:

1.59 Expungement of information or copy of papers in application file.

- (a) (1) Information in an application will not be expunged and returned, except as provided in paragraph (b) of this section. See § 1.618 for return of unauthorized and improper papers in interferences.
- (2) Information forming part of the original disclosure (i.e., written specification including the claims, drawings, and any preliminary amendment specifically incorporated into an executed oath or declaration under § § 1.63 and 1.175) will not be expunged from the application file.
- (b) An applicant may request that the Office expunge and return information, other than what is excluded by paragraph (a)(2) of this section, by filing a petition under this paragraph. Any petition to expunge and return information from an application must include the fee set forth in § 1.17(h).

and establish to the satisfaction of the Commissioner that the return of the information is appropriate.

M.P.E.P. 724.02 sets forth additional guidelines for such submissions:

724.02 Method of Submitting Trade Secret, Proprietary, and/or Protective Order Materials. Information which is considered by the party submitting the same to be either trade secret material or proprietary material, and any material subject to a protective order, must be clearly labeled as such and be filed in a sealed, clearly labeled, envelope or container. Each document or item must be clearly labeled as a "Trade Secret" document or item, a "Proprietary" document or item, or as an item or document "Subject To Protective Order." It is essential that the terms "Confidential," "Secret," and "Restricted" or "Restricted Data" not be used when marking these documents or items in order to avoid confusion with national security information documents which are marked with these terms (note also MPEP § 121). If the item or document is "Subject to Protective Order" the proceeding, including the tribunal, must be set forth on each document or item. Of course, the envelope or container, as well as each of the documents or items, must be labeled with complete identifying information for the file to which it is directed, including the Office or area to which the envelope or container is directed.

Examples of appropriate labels for such an envelope or container addressed to an application are as follows: (Appropriate changes would be made for papers filed in a reexamination file.)

A. "TRADE SECRET MATERIAL NOT OPEN TO PUBLIC. TO BE OPENED
ONLY BY EXAMINER OR OTHER AUTHORIZED U.S. PATENT AND
TRADEMARK OFFICE EMPLOYEE.

In re Application of

Application No.

Filed:

For: (Title of Invention)

TC Art Unit:

Examiner:

ATTENTION: (Current Location of Application)"

The envelope or container must be accompanied by a transmittal letter which also contains the same identifying information as the envelope or container. The transmittal letter must also state that the materials in the envelope or container are considered trade secrets or proprietary, or are subject to a protective order, and are being submitted for consideration under MPEP § 724. A petition under 37 CFR 1.59 and fee therefor (37 CFR 1.17(h)) to expunge the information, if found not to be important to a reasonable examiner in deciding whether to allow the application to issue as a patent, may also accompany the envelope or container.

724.05 Petition To Expunge Information or Copy of Papers in Application File

II. INFORMATION UNINTENTIONALLY SUBMITTED IN APPLICATION

A petition to expunge information unintentionally submitted in an application (other than information forming part of the original disclosure) may be filed under 37 CFR 1.59(b), provided that:

- (A) the Office can effect such return prior to the issuance of any patent on the application in issue;
- (B) it is stated that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted;
- (C) the information has not otherwise been made public;
- (D) there is a commitment on the part of the petitioner to retain such information for the period of any patent with regard to which such information is submitted;
- (E) it is established to the satisfaction of the Commissioner that the information to be returned is not material information under 37 CFR 1.56; and
- (F) the petition fee as set forth in 37 CFR 1.17(h) is included.

A request to return information that has not been clearly identified as information that may be later subject to such a request by marking and placement in a separate sealed envelope or container shall be treated on a case-by-case basis. Applicants should note that unidentified information that is a trade secret, proprietary, or subject to a protective order that is submitted in an Information Disclosure Statement may inadvertently be placed in an Office prior art search file by the examiner due to the lack of such identification and may not be retrievable.

As was noted above, the IDS contains both public and apparently confidential information which was inadvertently submitted. Only the information which is confidential may be returnable. However applicants have not specifically identified such items other than to supply a complete copy of the Form 1449 which accompanied the IDS listing all of the items submitted. Such does not appear to fully meet items (B) and (E) above.

The petition is **DISMISSED** subject to resubmission in proper form with identification of materials to be returned. Any renewed petition does not require a petition fee, if promptly submitted.

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, PO BOX 1450, ALEXANDRIA, VA 22313-1450, or by telephone at (703)308-3824 or by facsimile transmission at (703) 308-7230



Bruce M. Kisliuk
Director, Technology Center 1600